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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,705	01/08/2002	James Arthur Peterson	2992.02US02	5457

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EXAMINER

PANTUCK, BRADFORD C

ART UNIT PAPER NUMBER

3731

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/041,705

Applicant(s)

PETERSON ET AL.

Examiner

Bradford C Pantuck

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07/30/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-3, 11, 15, 16, 23-26, 34-37, and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear which figure Applicant is referring to that has a ridge portion that makes the bending beam thicker in a direction perpendicular to the plane defined by the two constraint segments. For example, in Figure 3 Ridge 49 only makes the beam thicker in the direction that is *in the same plane* as the plane defined by the two constraint segments. Ridge 49 is very thin (thinner than the rest of the clip) and extends from the top of the clip, *in the same plane as the rest of the clip*.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 11, 15, 16, 23-26, 34-37, and 45-47 are rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 4,217,902 to March in view of U.S. Patent No. 5,242,456 to Nash et al. Regarding Claims 1, 24, and

45, March discloses a surgical clip for retaining tissue [Column 1, lines 7-12] and for delivery by an applicator [see Fig. 6]. The clip has a bending beam (20/32/20) having shape memory to return to a relaxed position to retain tissue. March's clip further has two constraint segments (22 and 22), at alternative ends of beam (20/32/20) sufficiently rigid to retain tissue between their distal ends. The clip has two expansion engagement structures (44) [see Fig. 11] adapted for engaging the force application members (40 & 40) [Figure 11]. As the clip is opened from the view shown in Fig. 10 to the view shown in Fig. 11, the constraint segments (22 and 22) stay in the same plane.

March's clip further has a ridge portion (32) [Figures 7, 11] defined on the bending beam [see Attachment A]. Were the ridge not present, the beam would be slightly curved. The plane defined by the two constraint segments is the same plane as that of the page, for the view shown in Fig. 11. The ridge (32) of the beam is quite thick in the direction perpendicular to the page, as evident from the view shown in Fig. 7. Applicant says that the just mentioned thickness must be greater than "a thickness of the bending beam," a broad limitation. A thickness of the bending beam is the *height* of the bending beam as shown in Figure 11 of Attachment A. The thickness of ridge (32) into the page is greater than the thickness (height) of (a remainder of) the beam (Fig. 11). March's surgical clip is not made of a bioabsorbable material.

However, Nash discloses a similar clip having a resilient bending beam, and teaches that one ought to make such a clip out of bioabsorbable material so that the clip can be inserted inside of the body and left there [Column 18,

lines 59-68]. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to make March's clip out of a resorbable material so that the practitioner could apply the clip inside of the body and not have to perform a surgery at a later time in order to remove it, as taught by Nash.

3. Regarding Claims 2, 16, 25, 36, and 46, March's constraint segments have piercing portions ("teeth" 14) [see Figure 4, especially]. Such teeth are sharp and certainly capable of piercing tissue.
4. Regarding Claims 3, 23, 26, 37, and 47 March discloses two ridges (20) on his bending beam, and even calls them "ridges" [Column 3, line 48; see Figures 1 and 3]. Including these ridges, the beam is curved.
5. Regarding Claim 15, the components (44) provide a female mating member for male members (40) [Fig. 11].
6. Regarding Claims 11, 34 and 35, refer to Figures 4 and 5: March shows apertures (34 and 34), which are holes in the ridges (20) of the bending beam (20/32/20). As shown in Figure 6, force members (36 and 36) are inserted into these apertures. These apertures (along with the edges of the aperture) can be called expansion engagement structures, and are located proximally to the junction of the bending beam (20/32/20) and the constraint segments (22 and 22), as explained pictorially in Attachment #1.

*Response to Arguments*

7. Applicant's arguments filed July 30, 2004 have been fully considered but they are not persuasive. Applicant argues that the clips of U.S. Patent No. 4,217,902 to March are unrelated to the clips disclosed in U.S. Patent No. 5,242,456 to Nash et al. and that one of skill in the art of medical clips would not combine these two references. Examiner disagrees. Both patents have to do with medical clips for clipping body tissue, and consequently are in the same art. Although March discloses that his clips can be reusable, he also discloses that his clips can be discarded after one use [Column 2, lines 4-9]. Making clips out of a bioresorbable material is well known in the medical art, as clearly taught by Nash, as explained above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (703) 305-8621. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*BCP*

BCP

October 13, 2004

*22*  
ANH TUAN T. NGUYEN  
PRIMARY EXAMINER

*10/14/04*